

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YASUSHI FUJINAMI
and JUN YONEMITSU

Appeal No. 96-0809
Application 08/197,677¹

HEARD: FEBRUARY 11, 1999

Before KRASS, JERRY SMITH and LALL, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134
from the examiner's rejection of claims 1-13 and 15, which
constitute all the claims remaining in the application.

¹ Application for patent filed February 17, 1994. According to appellants, this application is a continuation of Application 07/921,122, filed July 29, 1992.

The disclosed invention pertains to an information recording medium having a plurality of information blocks. Each of the information blocks has a recording information area and an editing information area adjacent thereto. The editing information area allows for editing commands, such as a jump command, to be stored along with the useful information. Such an information recording medium is disclosed to improve the reproduction of only desired portions of the recording medium. The invention also relates to apparatus for recording information onto and reproducing information from the described information recording medium.

Representative claims 1 and 6 are reproduced as follows:

1. An information recording medium having table of contents (TOC) information recorded thereon in a TOC region and having recording information recorded thereon in a plurality of information blocks, each of said information blocks including a recording information area in which the recording information is recorded and an editing information area adjacent to said recording information area for recording therein editing information, the respective editing information area of at least one of said information blocks having recorded therein a jump command for indicating a point on said recording medium to which reproduction is to jump

after reproduction of the recording information recorded in the respective information block thereby reproducing only desired portions of said recording information in a desired sequence.

6. An apparatus for editing recording information recorded on a recording medium in a plurality of information blocks, each of said information blocks including a recording information area in which the recording information is recorded and an editing information area adjacent to said recording information area for recording therein editing information for editing the recording information recorded on said recording medium, the recording medium having table of contents (TOC) information recorded thereon in a TOC region, the apparatus comprising:

inputting means for inputting said editing information, the editing information inputted by said inputting means including a jump command for indicating a point on said recording medium to which reproduction is to jump;

recording means for recording the editing information inputted by said inputting means in at least some of said editing information areas on said recording medium, said jump command being recorded in at least one of said editing information areas; and

reproducing means for reproducing the recording information from said recording means and for responding to said jump command included in the editing information by jumping to said point on said recording medium indicated by said jump command and reproducing the recording information commencing at said point on said recording medium after reproducing the recording information recorded in the respective information block of the editing information area in which said jump command was recorded thereby reproducing only desired portions of said recording information in a desired sequence.

The examiner relies on the following references:

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Miller 1984	4,425,586	Jan. 10,
Maruta et al. (Maruta) 1991	5,056,075	Oct. 08,
Ando 1992	5,124,963	June 23,

The following rejections are before us on appeal:

1. Claims 1-3, 5/1, 5/2, 5/3, 6-13 and 15 stand rejected under 35 U.S.C. § 102(b) as anticipated by the disclosure of Miller.

2. Claims 1, 3, 4, 5/1, 5/3, 5/4, 6-8, 10, 11, 13 and 15 stand rejected under 35 U.S.C. § 102(e) as anticipated by the disclosure of Ando.

3. Claims 1-5 and 15 stand rejected under 35 U.S.C. § 102(e) as anticipated by the disclosure of Ando or alternatively under 35 U.S.C. § 103 as unpatentable over the teachings of Ando.

4. Claims 2, 5/2, 9 and 12 stand rejected under 35 U.S.C. § 103 as unpatentable over the teachings of Ando and Maruta.

Rather than repeat the arguments of appellants or the

examiner, we make reference to the brief² and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the prior art evidence relied upon by the examiner does not anticipate nor render obvious the invention as set forth in claims 1-13 and 15. Accordingly, we reverse.

Appellants have indicated that for purposes of this

² Appellants filed a reply brief on November 6, 1995 but this reply brief was denied entry by the examiner [Paper No. 28]. Therefore, we have not considered the reply brief in preparing this decision.

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appeal the claims will stand or fall together in the following three groups: Group I has claims 1-5 and 15, Group II has claims 6-9, and Group III has claims 10-13. Consistent with this indication appellants have made no separate arguments with respect to any of the claims within each group. Accordingly, all the claims within each group will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Accordingly, we will consider independent claims 1, 6 and 10 as the representative claims with respect to each of the rejections on appeal.

1. The rejection of claims 1-3, 5/1, 5/2, 5/3, 6-13 and 15 under 35 U.S.C. § 102(b) as anticipated by Miller.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L.

Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). The examiner has indicated how he reads these claims on the disclosure of Miller [answer, first and second pages numbered 3]. With respect to independent claim 1, appellants argue that the examiner has improperly ignored the limitation that the information recording medium is singular and that Miller does not disclose a jump command as recited in claim 1 [brief, pages 12-15]. The examiner responds that the presence of a second information recording medium in Miller is irrelevant because two information media discloses one information medium. The examiner also asserts that the editing/accessing information of Miller meets the jump command as recited and defined in claim 1 [answer, pages 5-6].

We agree with appellants on the question of whether Miller discloses the jump command as recited in claim 1. Although Miller does suggest that editing information about the useful information can be stored along with the useful information on plural storage media, Miller does not suggest

that this editing information includes the command to jump to another area of the recording medium. The editing information of Miller appears to be information only, not commands as required by claim 1. Although this may seem to be a minor distinction, anticipation under 35 U.S.C. § 102 requires that every feature of the claimed invention be present in a single prior art reference. Therefore, we do not sustain the rejection of claims 1-3, 5 and 15 as anticipated by the disclosure of Miller.

With respect to independent claims 6 and 10, appellants make the same arguments discussed above with respect to claim 1 as well as additional arguments that the recording and repro-ucing means of claim 6 and the controller means of claim 10 are not disclosed by Miller [brief, pages 21-25]. The examiner responds that the input means and recording/reproducing means are inherent in Miller [answer, page 6]. Although we agree that Miller inherently records and reproduces data, Miller does not suggest recording or reproducing a jump command in the editing information area of an information block as recited in the claimed invention. Therefore, we do not sustain the rejection

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of claims 6-13 as anticipated by Miller.

2. The rejection of claims 1, 3, 4,
5/1, 5/3, 5/4, 6-8, 10, 11, 13 and 15
under 35 U.S.C. § 102(e) as
anticipated by Ando.

The examiner has indicated how he reads these claims on the disclosure of Ando [answer, second page numbered 3]. With respect to independent claim 1, appellants argue that the examiner has improperly ignored the limitation of the "TOC information" and that Ando does not disclose a jump command stored with useful information as recited in claim 1 [brief, pages 15-18]. The examiner responds that the TOC editing information in Ando meets the claimed limitation [answer, page 7]. We agree with appellants that the TOC information of Ando does not meet the recitation of claim 1 that each information block has a recording information area as well as an editing information area and at least one of the information blocks has a jump command as recited in the claim. Therefore, we do not sustain the rejection of claims 1, 3-5 and 15 as anticipated by Ando.

With respect to independent claims 6 and 10,

appellants make the same arguments discussed above with respect to claim 1 as well as additional arguments that the recording and reproducing means of claim 6 and the controller means of claim

10 are not disclosed by Ando [brief, pages 21-25]. The examiner responds that the input means and recording/reproducing means are inherent in Ando [answer, page 7]. Although we agree that Ando inherently records and reproduces data, Ando does not suggest recording or reproducing a jump command in the editing information area of an information block as recited in the claimed invention. Therefore, we do not sustain the rejection of claims 6-8 and 10-13 as anticipated by Ando.

3. The rejection of claims 1-5 and 15 under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Ando.

For purposes of this rejection, the examiner has determined that the information content of the recording medium is not entitled to patentable weight because the information content is not functionally related to the record medium structure. Thus, the examiner asserts that the

information medium of claim 1 is not structurally different from the information medium of Ando. The examiner also simply concludes that it would have been obvious to store the information content of claim 1 on an information medium. Appellants argue that the claimed information structure cannot be ignored, citing In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994), and that the examiner has presented no evidence for his conclusion that the claimed information content would have been obvious to one having ordinary skill in the art [brief, pages 18-21]. The examiner responds that, unlike appellants' information, Lowry's data structures were physical entities and that appellants' claims are governed by the rule established in In re Gulack, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983) [answer, pages 7-8].

Although we agree with the examiner that the Lowry data structures are not exactly the same as appellants' information blocks and jump commands, we also agree with appellants that the current state of the law on this subject and the official PTO position is that claims such as the ones before us require the examiner to consider the content of the information for purposes of applying prior art rejections. In

other words, the examiner cannot simply assert that the content of the information is entitled to no patentable weight. The examiner must address the information content recited in a claim in the same manner as any other limitation of a claim is considered for prior art purposes. Since the examiner has not considered the information content for

the rejection under section 102 and has not demonstrated evidence of obviousness as required under section 103, we do not sustain this rejection of claims 1-5 and 15.

4. The rejection of claims 2, 5/2, 9 and 12 under 35 U.S.C. § 103 as unpatentable over Ando in view of Maruta.

These are dependent claims which recite that recording information includes video information and audio information. The examiner cites Maruta as teaching that it was well-known in the art to multiplex video and audio data on optical discs [answer, pages 4-5 and 8-9]. Since Maruta does not overcome the deficiencies of Ando noted above, and since these claims all depend from and incorporate the limitations of claims 1, 6

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or 10, we do not sustain the rejection of these dependent claims for the same reasons discussed above.

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In summary, we have not sustained any of the
examiner's rejections of the claims on appeal. Therefore, the
decision of
the examiner rejecting claims 1-13 and 15 is reversed.

REVERSED

	ERROL A. KRASS)	
	Administrative Patent Judge)	
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	JERRY SMITH)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	PARSHOTAM S. LALL)	
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